

Doc Code: AP,PRE,REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0051-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		YOR920000812US1 / I28-0001	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.0(a)] on _____ Signature _____ Typed or printed name _____		Application Number	Filed
		09/847,557	May 2, 2001
		First Named Inventor	
		Art Unit	Examiner
		3627	Lynda Jasmin
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the		<i>Marisa J. Dubuc</i> Signature	
<input type="checkbox"/> applicant/inventor.		Marisa J. Dubuc Typed or printed name	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/06)		(860) 286-2929 Telephone number	
<input checked="" type="checkbox"/> attorney or agent of record. 46,673 Registration number		November 23, 2005 Date	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.111, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR CONFIDENTIAL FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

RECEIVED
CENTRAL FAX CENTER

NOV 23 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: ANDREW VARGA ET AL.)
Serial No.: 09/847,557) Group Art Unit: 3627
Filed: May 2, 2001)
For: METHOD AND SYSTEM FOR MANAG-) Examiner: Lynda Jasmin
ING PARTS REQUIREMENTS) Confirmation No.: 5973
PROCESSES)
)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Pre-Appeal Brief Request for Review

In response to the Final Office Action dated August 24, 2005, an Advisory Action dated November 11, 2005, and in conjunction with the concurrently filed Notice of Appeal, the Applicants submit the following for entry in the above-identified application.

REMARKS

Claims 1-9, 11-15, 17-19, 21, 23-27, 29-31, and 33-35 are pending in the instant application. In the Final Office Action of August 24, 2005, the Examiner rejected claims 1-9 under 35 U.S.C. 101 as being allegedly directed to non-statutory material. In particular, the Examiner stated that the claims "are neither directed to a 'process' nor a 'machine', but rather embrace or overlap two different statutory classes of invention" (Final Office Action, page 3). The Examiner also rejected claims 1-9 under 35 U.S.C. 112, second paragraph as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention, stating that it is "unclear whether the Applicant is claiming a machine or a process." The Examiner further rejected claims 1-9, 11-15, 17-19, 21, 23-27, 29-31, and 33-35 as being allegedly anticipated by U.S. Patent Publication No. 2002/0184111 to Swanson.

In the Advisory Action dated November 11, 2005, the Examiner withdrew the rejections of claims 1-9 under 35 U.S.C. 101; however, the Examiner did not specify whether the similar rejections under 35 U.S.C. 112, second paragraph, regarding claims 1-9 has been maintained. In the event that these rejections have been maintained, the Applicants herewith address them and submit that the rejections of claims 1-9 as being indefinite under 35 USC 112, second paragraph, are in error. The Applicants further submit that the rejections of claims 1-9, 11-15, 17-19, 21, 23-27, 29-31, and 33-35 are in error because the Examiner has not met the burden of establishing a *prima facie* case of anticipation in contravention of the provisions of 35 USC 102.

The Examiner states that claims 1-9 are indefinite because the claims are "directed to neither a 'process' or a 'machine,' but rather embrace or overlap two different statutory classes of invention" (Page 3, item 5 of the Final Office Action dated August 24, 2005). The Examiner cites MPEP 2173.05(p) II or *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I., 1990) in support. The Applicants submit that the Examiner application of the teachings of *Lyell* to the instant application is improper.

The provisions of 35 USC 101 state "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement

thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.” Applicants’ claim 1 recites a system that includes “a server in communication with a workstation over a network, the workstation executing a design tool application; a bill of material assist application executing on at least one of the server and the workstation for managing said parts requirements processes”. Thus, the system recited in claim 1 is classified as a machine and is proper statutory subject matter in accordance with 35 USC 101.

Claim 1 continues on to recite “the bill of material assist application performing: receiving a bill of material including a list of component parts in response to a product design conducted on the workstation; mapping each component part in the list to corresponding part selection process information, the corresponding part selection process information acquired from the plurality of external sources; and generating a summary resulting from the mapping.” As recited, the bill of material assist application is directed to a program or software executing on the workstation or server. The Examiner’s assertion that the claim recites overlapping statutory classes of subject matter (i.e., machine and process) is in error. The Court has held that “a computer operating pursuant to software may represent patentable subject matter, provided, of course, that the claimed subject matter meets all of the other requirements of title 35.” *In re Alappat*, 33 F.3d 1526, 1545, 31 USPQ2d 1545 (Fed. Cir. 1994); see also *In re Lowry* 32 F.3d 1549, 32 USPQ2d 1031 (Fed.Cir. 1994). More recently, the Court in *WMS Gaming Inc. v. International Game Technology*, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999), citing *In re Alappat*, held that a “general purpose computer, or microprocessor, programmed to carry out an algorithm creates ‘a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software,’ *In re Alappat*; see also *In re Bernhart*, 417 F.2d 1395, 1399-1400, 163 USPQ 611, 615-16 (CCPA 1969).

In the alternative, the Applicants submit that the format of the claim 1 as recited may be compared to that of a “means-plus function” format. The workstation and/or server execute a ‘means’ (i.e., the bill of material assist application) for implementing a process. ‘Means-plus’ function claims have been held to be proper statutory subject matter as falling within the category of machine or manufacture. For example, in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998), the Court held that the “means-plus function” format of the claim was properly recited as a machine and not a process

and was statutory patentable subject matter. *State Street Bank* is directed to a data processing system for implementing an investment structure. The Court went on to state that “for the purposes of a 101 analysis, it is of little relevance whether [the] claim...is directed to a ‘machine’ or a ‘process,’ as long as it falls within at least one of the four enumerated categories of patentable subject matter, ‘machine’ and ‘process’ being such categories.”

As recited, Applicants’ claim 1 falls within a single statutory class, that is, a machine and accordingly, is patentable subject matter under 35 USC 101 and, in addition, is sufficiently definite as defined within the provisions set forth in 35 U.S.C. 112, second paragraph. Thus, there exists clear error in the outstanding rejections of claims 1-9 under 35 USC 112.

With respect to the rejections of claims 1, 34, and 35 under 35 USC 102(e), the Examiner states that Swanson teaches each and every element recited therein. The Applicants submit that the rejections of claims 1, 34, and 35 are in error because the Examiner has not made a prima facie case of anticipation. In particular, Swanson neither teaches, nor suggests “a bill of material assist application...receiving a bill of material including a list of component parts in response to a product design conducted on the workstation.” Swanson makes a generalized reference to a Bill of Material (paragraph 0067) but is entirely devoid of teaching “*receiving a bill of material...in response to a product design conducted on the workstation.*” In addition, Swanson fails to teach or disclose “mapping each component part in the list to corresponding part selection process information, the corresponding part selection process information acquired from a plurality of external sources.” Rather Swanson teaches “bill of materials (BOM) and add-on information can be obtained” via a multi-media display window (FIG. 13) that displays product component information for a product that can be accessed, sorted, and filtered (paragraph 0107) but does not specifically teach “mapping each component part in the list to corresponding part selection process information...acquired from a plurality of external sources” as recited in Applicants’ claims 1, 34, and 35.

In addition, Swanson is devoid of teaching or suggesting “generating a summary resulting from the mapping” and “for each of the component parts in the list, the corresponding part selection process information includes...a current supply status.” The mapping, as recited in the claims, refers back to the component part in the list that results from the product design conducted, the component parts mapped to corresponding part selection process information.

Swanson, by contrast, teaches a "report module must present the status of the data entry for each part" (paragraph 0082). If the Examiner is suggesting that the status of the data entry is equivalent to the summary resulting from the mapping, then this application of Swanson to the Applicants' claims is in error. The Claims 1, 34, and 35 recite the summary generated as a result of the mapping, wherein the status of the data entry for each part refers to custom data entry processes (paragraph 0082).

Accordingly, because Swanson does not teach or suggest each and every element of Applicants' claims 1, 34, and 35, the Applicants submit that there is clear error in the rejections of claims 1, 34, and 35.

In view of the foregoing, it is urged that the final rejection of claims 1, 34, and 35 be overturned. The final rejection is in error and should be reversed. The fee set forth in 37 CFR 41.20(b)(1) is enclosed herewith. If there are any additional charges with respect to this Request, or otherwise, please charge them to Deposit Account No. 50-0510.

Respectfully submitted,

ANDREW VARGA ET AL.

CANTOR COLBURN LLP
Applicants' Attorneys

By: Marisa J. Dubuc
Marisa J. Dubuc
Registration No. 46,673
Confirmation No. 5973
Customer No. 48915

Date: November 23, 2005
Address: 55 Griffin Road South, Bloomfield, CT 06002
Telephone No: (860) 286-2929
Fax No: (860) 286-0115